

REMARKS

Claims 1-18 are pending in this application. Claims 1, 4, 7 and 10-15 are independent claims.

Reconsideration in view of the following remarks is respectfully solicited.

The Claims Define Patentable Subject Matter

The final Office Action rejects:

(1) claims 1-15 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,684,087 to Yu et al. (hereafter Yu) in view of U.S. Patent No. 6,940,526 to Noda et al. (hereafter Noda); and

(2) claims 16-18 under 35 U.S.C. §103(a) as being unpatentable over Yu in view of Noda and further in view of U.S. Patent No. 6,639,603 to Ishii (hereafter Ishii).

These rejections are respectfully traversed.

Applicant respectfully submits that the combination of Yu and Noda, with or without Ishii, fails to teach or suggest each and every feature as set forth in the claimed invention.

In the present invention, as set forth in independent claims 1, 4 and 7, a processed image data set is generated by cutting out an area from an image represented by a selected one of the image data sets according to the changeable image area that has been specified, wherein the changeable image area is arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal.

The Examiner concedes that Yu fails to disclose that the image area is a changeable image area wherein the size and the position of the changeable image area are arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal (see final Office Action, page 4). However, in an attempt to show this feature the Examiner imports Noda.

Specifically, the Examiner alleges that such a feature is well known in the art as taught by Noda's image synthesizing method for a communication terminal in which "the operator may

change the position and size of the crop boundary 84 relative to the second image 88 to designate an area to be pasted in the inner frame 47b". (see final Office Action, page 4).

However, Applicant respectfully submits that a close review of Noda reveals a very distinguishable method/apparatus.

For example, Noda merely teaches an apparatus in which *a main image is superimposed on a background image*. When superimposing, the main image is cropped and pasted on the background image maintaining the aspect ratio of the cropped main image. The aspect ratio of the main image is designated by a user to appropriately fit the main image on the background image.

In contrast, the aspect ratio of an image of the present invention is designated according to *the specification of a screen of a mobile terminal* to which an image would be transferred. The aspect ratio in the present invention is not adjusted by a *user*, as done in Noda. Furthermore, the present invention is directed to a system that includes a PC, with which a user can manipulate an image, and a server, which is connected to the PC via a network. In the present invention, the information regarding the aspect ratio of a screen of a *mobile terminal* is stored in the *server*. In the present invention, a user does not necessarily have to designate the aspect ratio because such information is supplied from the server.

In other words, Noda fails to disclose designating an aspect ratio of an image *according to the specification of a screen of a mobile terminal* to which an image would be transferred. Instead, Noda merely crops and pastes a main image onto a background image while maintaining the aspect ratio of the cropped main image. Noda fails to consider the specification of a screen of a mobile terminal in designating the aspect ratio. Noda merely relies upon the user to designate the aspect ratio.

Accordingly, Applicant respectfully submits that one of ordinary skill in the art would not be motivated to combine Yu with Noda, because Noda is completely silent about cropping an image having an aspect ratio corresponding to that of a screen of a mobile terminal.

For at least the reasons noted above, Applicant respectfully submits that the combination of Yu and Noda fails to teach or suggest that the size and the position of a changeable image area

is arbitrarily designated by a user while maintaining the specification of the screen of the mobile terminal.

Applicant also respectfully submits that Ishii fails to make up for the deficiencies found in Yu and Noda.

Applicant respectfully submits that neither Yu, Noda nor Ishii, taken singularly or in combination, (assuming these teachings may be combined, which Applicant does not admit) teach or suggest a changeable image area that is arbitrarily designated by a user to determine size and position.

To establish a *prima facie* case of Obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

Applicant respectfully submits that the combination of Yu and Noda (with or without Ishii) fail to teach or suggest each and every feature as set forth in the claimed invention.

Applicant respectfully submits that independent claims 1, 4 and 7 are allowable over the combination of Yu and Noda for at least the reasons noted above. Furthermore, Applicant respectfully submits that independent claims 10-15 are allowable over the combination of Yu, Noda, and Ishii for at least the reasons noted above.

As for each of the dependent claims not particularly discussed above, these claims are also allowable for at least the reasons set forth above regarding their corresponding independent claims, and/or for the further features claimed therein.

Accordingly, withdrawal of the rejection of claims 1-18 under 35 U.S.C. §103(a) is respectfully requested.

Noda is Disqualified as Prior Art

Applicant respectfully points out to the Examiner that, according to MPEP §706.02(l)(1), subject matter which was prior art under former 35 U.S.C. 103 *via* 35 U.S.C. 102(e) is now *disqualified as prior art* (emphasis added) against the claimed invention if that subject matter and the claimed invention “were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

Applicant respectfully advises the Examiner that the present application and the cited reference Noda were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. The required evidence of common ownership is shown in the Assignment papers filed on October 29, 2003 in the present application, depicting “Fuji Photo Film Co., Ltd.” as the common owner between the present application and the cited Noda (USP 6,940,526) reference.

In other words, Application 10/694,938 and Patent 6,940,526 were, at the time the invention of Application 10/694,938 was made, owned by Fuji Photo Film Co., Ltd..

Accordingly, Applicant respectfully submits that the secondary reference, USP 6,940,526 to Noda et al., used for the 103(a) rejection in the final Office Action is now *disqualified as prior art* against the claimed invention.

Applicant respectfully submits that as conceded by the Examiner, USP 6,684,087 to Yu fails to make up for the disqualification of USP 6,940,526 to Noda. As such, Applicant respectfully submits that claims 1-18 are allowable, for at least the reasons set forth above, over the cited references.

Accordingly, withdrawal of the rejections of claims 1-18 under 35 U.S.C. §103(a) in the November 1, 2006 final Office Action is respectfully solicited.

Conclusion


In view of the foregoing, Applicant respectfully submits that the application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Carolyn T. Baumgardner (Reg. No. 41,345) at (703) 205-8000 **to schedule a Personal Interview.**

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment from or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17; particularly, the extension of time fees.

Dated: February 1, 2007

Respectfully submitted,

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